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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1753	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/902,933	Applicant(s) BECKER ET AL
	Examiner ALEX NOGUEROLA	Art Unit 1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 20-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 20-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,294,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of claim 1 of the instant application encompasses the scope of claim 1 of U.S. Patent No. 6,294,063 B1. The two claims only differ in that claim 1 of U.S. Patent No. 6,294,063 B1 restricts the means for generating programmable manipulation forces to only generating dielectrophoretic or electrophoretic forces while the means for generating programmable manipulation forces in claim 1 of the instant application is not restricted to generating these two forces.

3. Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,294,063 B1. Claim 1 from

which claim 2 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 2 of the instant application is verbatim the same as the limitation required by claim 2 of U.S. Patent No. 6,294,063 B1.

4. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,294,063 B1. Claim 1 from which claim 3 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 3 of the instant application is verbatim the same as the limitation required by claim 3 of U.S. Patent No. 6,294,063 B1.

5. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,294,063 B1 in view of JPO computer translation of Masahiro et al. (JP 09-043434), hereafter "Masahiro". Claim 4 of the instant application differs from claim 1 of U.S. Patent No. 6,294,063 B1 in that claim 1 of U.S. Patent No. 6,294,063 B1 only mentions that dielectrophoretic or electrophoretic forces are to be generated by the means for generating programmable manipulation forces while claim 4 of the instant application requires the means for generating manipulation forces to comprise a light source. Masahiro teaches a means for generating manipulation forces comprising a light source, in particular an optical tweezer (abstract). It would have been obvious to one with ordinary skill

in the art at the time the invention was made to use an optical tweezer in the invention of claim 1 of U.S. Patent No. 6,294,063 B1 because as taught by Masahiro particles can be more easily manipulated with an optical tweezer than with means for generating Coulomb manipulation forces (paragraph [0004] of *Detailed Description*), of which electrophoresis is an example.

6. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,294,063 B1. Claim 1 from which claim 5 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. Patent No. 6,294,063 B1 provides means for generating programmable manipulation forces by dielectrophoretic or electrophoretic forces.

7. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,294,063 B1. Claim 1 from which claim 6 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 6 of the instant application is verbatim the same as the limitation required by claim 4 of U.S. Patent No. 6,294,063 B1.

8. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,294,063 B1. Claim 1 from which claim 8 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 8 of the instant application is verbatim the same as the limitation required by claim 5 of U.S. Patent No. 6,294,063 B1.

9. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,294,063 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of claim 20 of the instant application encompasses the scope of claim 17 of U.S. Patent No. 6,294,063 B1. The two claims only differ in that claim 17 of U.S. Patent No. 6,294,063 B1 restricts the programmable manipulation forces to dielectrophoretic or electrophoretic forces while the programmable manipulation forces in claim 20 of the instant application are not restricted to these two forces.

10. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 21 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 21 of the instant application is the same as the limitation required by claim 18 of U.S. Patent No. 6,294,063 B1.

11. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 22 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 22 of the instant application is the same as the limitation required by claim 19 of U.S. Patent No. 6,294,063 B1.

12. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent No. 6,294,063 B1. Claim 22 from which claim 23 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 23 of the instant application is the same as the limitation required by claim 20 of U.S. Patent No. 6,294,063 B1.

13. Claim 24 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,294,063 B1. Claim 22 from which claim 24 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 24 of the instant application is the same as the limitation required by claim 21 of U.S. Patent No. 6,294,063 B1.

14. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 25 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 25 of the instant application is the same as the limitation required by claim 22 of U.S. Patent No. 6,294,063 B1.

15. Claim 26 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 26 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of U.S. Patent No. 6,294,063 B1 provides for generating programmable manipulation forces by dielectrophoretic or electrophoretic forces

16. Claim 27 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 27 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 27 of the instant application is the same as the limitation required by claim 23 of U.S. Patent No. 6,294,063 B1.

17. Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,294,063 B1. Claim 20 from which claim 28 depends has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation required by claim 28 of the instant application is the same as the limitation required by claim 24 of U.S. Patent No. 6,294,063 B1.

Claim Rejections - 35 USC § 112

18. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

Claim 27 recites the limitation "said sensing" in line 1. There is insufficient antecedent basis for this limitation in the claim.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (703) 305-5686. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Alex Noguerola
Alex Noguerola
11/14/03
Primary Examiner
TC1753